

**REMARKS**

Applicant respectfully requests the Examiner to reconsider the present application in view of the foregoing amendments to the claims.

***Status of the Claims***

In the present Reply, claim 1 has been amended. Also, claims 17-21 were previously canceled without prejudice or disclaimer of the subject matter contained therein. Thus, claims 1-16 are pending in the present application.

No new matter has been added by way of the amendment to claim 1 in that Shore A hardness has been added. Applicant notes that the JIS K6253 method refers to Shore A hardness. Further, this is a clarifying and not a narrowing amendment. By adding the "Shore A" definition in order to clarify the claimed invention, Applicant is in no way conceding any limitations with respect to the interpretation of the claims under the Doctrine of Equivalents.

Based upon the above considerations, entry of the present amendment is respectfully requested.

In view of the following remarks, Applicant respectfully requests that the Examiner withdraw all rejections and allow the currently pending claims.

***Issues under 35 U.S.C. § 112, Second Paragraph***

Claims 1-12 stand rejected under 35 U.S.C. § 112, second paragraph, for asserted reason of indefiniteness. Applicant respectfully traverses, and reconsideration and withdrawal of this rejection are respectfully requested.

Applicant respectfully refers the Examiner to the scope of claim 1 as presented herein, wherein the units of (Shore A) hardness are defined. Thus, claim 1 recites clear and definite claim language. Reconsideration and withdrawal of this rejection are respectfully requested.

***Issues under 35 U.S.C. § 103(a)***

Claims 1-11 and 13-16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas '806 (U.S. Patent No. 5,553,806) in view of Harkins '462 (U.S. Patent No. 2,353,462) (see pages 2-4 of the Office Action).

Also, claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lucas '806 in view of Harkins '462 as applied to claims 1, 10 and 11 above, and further in view of Perrigo '373 (U.S. Patent 5,035,373).

Applicant respectfully traverses, and reconsideration and withdrawal of these rejections are respectfully requested. In summary, Applicant does not concede that a *prima facie* case of obviousness has been established with respect to either rejection.

The Present Invention and Its Advantages

Cellulose acylate film can be manufactured by, e.g., a method of solution casting film forming (see Applicant's specification at page 1, starting at line 14). However, such a method, as well other methods, lead to drawbacks, such as instable winding, accidental sink or recess in an upside of the film roll, foreign material or particles via electrostatic charge contaminating the produced films and degradation of the rubber surface material of the lay-on roll (see the present specification at page 2, lines 3-15 and page 2, line 22 to page 3, line 8).

In contrast, the present invention unexpectedly solves such drawbacks. In the present invention, a film winding method is provided in which electrification due to a lay-on roll in winding polymer film is suppressed (see, e.g., volume resistivity and Shore A hardness of claim 1). The present invention is also directed to a status of a film roll with the claimed method. With the present invention, a polymer film can be manufactured with not only high quality but with improved, high reliability (as described in the present specification at, e.g., page 3, lines 11-17). Such unexpected advantages are even experimentally confirmed as shown in Applicant's specification at, e.g., Tables 3-5 at on pages 11-13.

In contrast, the cited combination of Lucas '806 and Harkins '462 fails to disclose such features and advantages of the present invention. Applicant further notes that Lucas '806 cannot be properly combined with Harkins '462 as explained below. The explanation below notes the differences between the references followed by why the present invention would not be produced by the skilled artisan.

Distinctions over Lucas '806 and Harkins '462: Claims 1-11 and 13-16

The Examiner refers Applicant to column 6, lines 20-26 of Lucas '806 for the disclosure of the winding roll's surface hardness value as asserted to be within the range of instantly pending claim 1 (see page 3, first paragraph of the Office Action). However, the objective of the primary reference of Lucas '806 is winding a paper effectively (see the title of the patent as well as column 2, line 65 to col. 3, line 14 of this reference). Thus, though Lucas '806 relates to paper winding, the cited primary reference is quite different from the present invention in view of the actual material being wound with a winding roll.

As mentioned, with the present invention, a polymer film can be manufactured with not only high quality but with improved, high reliability. Thus, in forming the instant rejection, the Examiner has not accounted for the presently claimed feature of "winding continuous polymer film into a form of a film roll." This deficiency of Lucas '806 is further noted and used below. Additionally, Lucas '806 fails to disclose or suggest the volume resistivity recited in instantly pending claim 1 anywhere in its disclosure (as also stated in the Office Action at page 3, second paragraph). Thus, Lucas '806 fails to disclose the claimed features of (i) winding continuous polymer film as well as (ii) the volume resistivity.

Harkins '462 does not account for all deficiencies of the primary reference and cannot be properly combined with Lucas '806 in order to produce the present invention. In the Office Action, the Examiner refers Applicant to page 3, column 1 lines 15-21 of Harkins '462. In this regard, Harkins '462 appears to disclose that the subject or material being wound by the winding roll is a textile material. The objective of Harkins '806 is effectively winding textile and

dispersing the static charge generated in the winding to thereby reduce the tendency of the fibers to cling to the rollers (see the title; see also col. 1, line 52 to col. 2, line 7). Further, Harkins '462 teaches a different winding roll surface hardness and volume resistivity at page 3, first column, lines 15-22 as compared to the claimed invention.

Given such disclosure, one of ordinary skill in the art would not be motivated or reasonably expect to be successful in making the present invention based on the disclosure in Lucas '806 and Harkins '462. First, Harkins '462 is different in the winding roll's surface hardness versus the present invention or Lucas '806. Specifically, Harkins '462 suggests that the winding roll's surface hardness (Shore A type) is 85 (see the sentence at page 3, first column, line 22 under the Table) as well as 80 (same column but at line 31). Therefore, Harkins '462 is different from the range of the hardness 30-70 of instantly pending claim 1. Also, Harkins '462 does not account for all deficiencies of the primary reference (e.g., winding a continuous polymer film).

Accordingly, the present invention would not be made by one of ordinary skill in the art. Applicant notes that U.S. case law squarely holds that a proper obviousness inquiry requires consideration of three factors: (1) the prior art reference (or references when combined) must teach or suggest all the claim limitations; (2) whether or not the prior art would have taught, motivated, or suggested to those of ordinary skill in the art that they should make the claimed invention (or practice the invention in case of a claimed method or process); and (3) whether the prior art establishes that in making the claimed invention (or practicing the invention in case of a claimed method or process), there would have been a reasonable expectation of success. *See*

*In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438, 1442 (Fed. Cir. 1991). Here, the requisite motivation and/or reasonable expectation of success are lacking.

This is because even assuming that the rubber of which volume resistivity as specifically recited in Harkins '462 is used in the lay-on roll of the primary reference of Lucas '806, the resulting lay-on roll (due to the combination of Lucas '806 and Harkins '462) would not be the same or equivalent with that of at least claim 1 of the present invention. In this regard, the requisite motivation is lacking when the Examiner's proposed modification or combination renders a reference unsatisfactory for its intended purpose. *See re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see also* M.P.E.P. § 2143.01.

Alternatively, Applicant respectfully submits that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. *See In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); M.P.E.P. §§ 2143.01 (see sections entitled "The Proposed Modification Cannot Render the Prior Art Unsatisfactory For Its Intended Purpose" and "The Proposed Modification Cannot Change the Principle of Operation of a Reference") and M.P.E.P. § 2145(III). Here, inserting the volume resistivity as specifically recited in Harkins '462 into the lay-on roll of the primary reference of Lucas '806 would defeat the intended purpose of Lucas '806 or render this reference as inoperable.

As mentioned, Lucas '806 is directed to winding a paper effectively and Harkins '462 is directed to rolling textiles. It is not clear that such an apparatus as a result of the combination of disclosures of the two cited references would even work. At the very least, Applicant

respectfully submits that the present invention would not be produced since, e.g., Harkins '462 has different Shore A hardness for its textile apparatus. Insertion of this hardness into Lucas '806 still does not achieve the present invention and is even inconsistent with the Lucas '806 disclosure. Thus, the requisite motivation for a *prima facie* case of obviousness is lacking.

Furthermore, the initial burden of establishing a *prima facie* case of obviousness lies with the examiner. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984). Here, the requirement of disclosure of all claimed features has not been satisfied. *In re Vaeck; supra*. Specifically, neither Lucas '806 nor Harkins '462 discloses an apparatus that would wind a polymer film as instantly claimed. Thus, the Examiner has not met the initial burden of establishing a *prima facie* case of obviousness.

Though the Examiner states that the Lucas '806 apparatus is "capable of winding a wide range of web materials", Applicant respectfully traverses such a conclusion (see the Office Action at page 3, last paragraph). This is too much of a simplification of what Lucas '806 actually discloses.

Further, while patents are relevant as prior art for all they contain, they cannot be relied upon to teach embodiments that are not reasonably suggested to one having ordinary skill in the art. See *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804 (Fed. Cir. 1989). In the instant case, the skilled artisan could not reasonably infer from the above passage that the apparatus of Lucas '806 possesses the ability to roll a polymer film.

In addition, Harkins '462 discloses a different hardness for its roll versus the Lucas '806 embodiment. Again, the cited references cannot be relied upon to teach embodiments that are not reasonably suggested to one having ordinary skill in the art.

Further, the rollers in Harkins '462 are for a different purpose (e.g., textile fibers as disclosed at page 3, left column, lines 32-51) versus the primary reference or from the present invention. One of ordinary skill in the art would realize the disclosure in each reference being distinct from one another (or even the title of each reference). In this regard, the Federal Circuit in *In re Oetiker* stated:

We have reminded ourselves and the PTO that it is necessary to consider "the reality of the circumstances", *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979) -- in other words, common sense -- in deciding in which fields a person of ordinary skill would reasonably be expected to look for a solution to the problem facing the inventor. It has not been shown that a person of ordinary skill, seeking to solve a problem of fastening a hose clamp, would reasonably be expected or motivated to look to fasteners for garments. The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a *prima facie* case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself.

24 USPQ2d 1443, 1446 (Fed. Cir. 1992) (citing *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678-79, 7 USPQ2d 1315, 1318 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 687, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1147, 227 USPQ 543, 551 (Fed. Cir. 1985). In this respect, Applicant respectfully submits that the instant invention cannot be produced given the nonanalogous art as disclosed in Lucas '806



and/or Harkin '462. Thus, reconsideration and withdrawal of this rejection under § 103(a) are respectfully requested under *In re Oetiker* for this additional reason.

Distinctions over Lucas '806, Harkins '462 and Perrigo '373: Claim 12

Instantly pending claim 12 ultimately depends on claim 1. Thus, Applicant respectfully submits that all of the above arguments with respect to the combination of Lucas '806 and Harkins '462 apply to this rejection as well. The addition of Perrigo '373 does not make the initial combination of Lucas '806 and Harkins '462 any more proper. Thus, the rejection of claim 12 is also improper for the reasons as previously stated above.

Unexpected Results

Applicant respectfully submits that the present invention has achieved unexpected results, whereby such results rebut any asserted *prima facie* case of obviousness (whether based on Lucas '806, Harkins '462, Perrigo '373 or any other reference or combinations thereof). *See In re Corkill*, 711 F.2d 1496, 226 USPQ 1005 (Fed. Cir. 1985); *see also In re Papesch*, 315 F.2d 381, 137 USP 43 (CCPA 1963); *In re Wiechert*, 370 F.2d 927, 152 USPQ 247 (CCPA 1967). As stated in M.P.E.P. § 2144.09 (see section entitled "*Prima Facie* Case Rebuttable By Evidence of Superior or Unexpected Results"), any rejection under 35 U.S.C. § 103(a) may be rebutted by a sufficient showing of unexpected results for the present invention.

As mentioned, the present invention has achieved unexpected results in improving various properties. The present specification starting at page 9 shows how the present invention

produces better film roll quality, less electrification, no belt-shaped failure, etc. Thus, reconsideration of the patentability of the present invention is respectfully requested in light of these unexpected results for the present invention.

**Summary of Applicant's Position**

One of ordinary skill in the art would lack the requisite motivation and/or reasonable expectation of success since the cited references are not in analogous art with the present invention, and the cited references would be rendered inoperable or the intended purpose(s) thereof would be destroyed. Further, the skilled artisan could not reasonably infer from the apparatus of Lucas '806 or that of Harkins '462 that such an apparatus possesses the ability to roll a polymer film as instantly claimed. Also, any further combination with Perrigo '373 does not make the first combination of Lucas '806 and Harkins '462 any more proper.

Therefore, for the reasons stated above, a *prima facie* case of obviousness has not been established for either rejection since not all requirements thereof have been satisfied. Accordingly, reconsideration and withdrawal of both rejections are respectfully requested.

***Conclusion***

A full and complete response has been made to all issues as cited in the Office Action. Applicants have taken substantial steps in efforts to advance prosecution of the present application. Thus, Applicants respectfully request that a timely Notice of Allowance issue for the present case.

**Application No. 10/665,497**  
**Art Unit 3654**  
**Reply to Office Action of July 27, 2005**

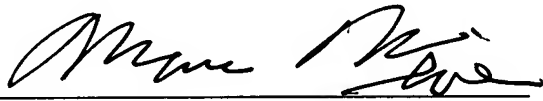
**Docket No.: 1259-0237P**

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Eugene T. Perez (Reg. No. 48,501) at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

Marc S. Weiner

Registration No.: 32,181

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Road, Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant